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| 09/722,962 | 11/27/2000 | Larry A. Greenspan | 08563-0087 | 5141 |
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| PAMELA R. CROCKER EASTMAN KODAK COMPANY, PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201 | | | EXAMINER PORTER, RACHEL L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,962

Applicant(s)

GREENSPAN ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-71, 73, 74, 76-87 and 89-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-71, 73, 74, 76-87 and 89-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendments filed 8/1/05. Claims 61-71, 73-74, 76-87, and 89-92 are pending.

Specification

2. The amendment filed 8/1/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: The Applicant has removed certain material (e.g. page 19, 3rd paragraph of the response) and has replaced the term "healthcare" with "dental" in several instances throughout the specification. However, it is noted that these replacements are not commensurate with the scope of the disclosure as originally filed and in many instances do not reflect the text of the original filed drawings/figures. Furthermore, the Applicant has altered the language of the specification in a manner that mentions dental application as a possible application (page 19 of the response, 3rd paragraph), to now disclose that it is the only embodiment.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 61-71, 73-74, 76-87, and 89-92 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims as currently drafted are specifically drawn to a method and system for producing a dental presentation for a patient. For example, claim 61 currently recites that a template is formed to produce "a dental presentation template...wherein the dental presentation template comprises at least one specific dental procedure indicator for use as a point of incorporation for specific dental information on the recommended course of treatment..." (Step 1a). Claim 61 further recites other details such as "scanning the template for a marker, wherein the marker identifies **dental** information specific to the dental patient..." "retrieving dental information specific to the dental patient identified by the marker by the from the dental desktop application..."

However, the scope the originally filed specification is not commensurate with that of the currently pending claims in terms of describing Applicant's invention. In particular, the specification appears to be much more generic in its references to the steps performed and the system used to generate a (healthcare) presentation. While there are occasional references to the American Dental Association (primarily in the background of the invention), the originally filed disclosure does not contain the degree

of detail regarding developing dental presentations now found in the currently pending claims.

As such, the Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed disclosure, or to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 61-63, 66-71, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828) in view of Clark et al (USPN 6,171,112), and in further view of Official Notice.

[claims 61 and 69] Sachdeva teaches a method for generating and tracking presentations for a dental patient describing a recommended course of dental treatment comprising of at least one dental procedure, the method comprising the steps of:

a. forming at least one template configured for display as a dental presentation template, wherein the template is formed for display utilizing a computer, wherein the

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dental presentation template comprises at least one specific dental procedure indicator for use as a point of incorporation for specific dental information on the recommended course of treatment; (col. 3, lines 4-col. 4, line 8; col. 4, lines 24-38)

b. inserting in each template at least one general information indicator for use as a point of incorporation for general information on the dental patient; (col. 4, lines 9-65)

c. incorporating specific dental information about the specific dental procedure from the recommended course of treatment for the dental patient into the template; (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15)

d. incorporating the general information on the dental patient into at least one template; (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15)

e. generating a dental presentation using at least one template with the incorporated specific dental information and the general information on the dental patient with one step utilizing the computer; (col. 5, lines 32-col. 6, lines 15)

f. storing the dental presentation in a dental desktop application; (col. 3, lines 58-col. 4, line 8)

g. presenting the dental presentation to the dental patient; and (col. 4, lines 24-27: displaying treatment plan; col. 6, lines 3-33—patient acknowledges simulated treatment results)

Sachdeva discloses a method as explained above, and further disclose that the dental presentation is provided to the patient to acknowledge information in the presentation. (col. 6, lines 3-33). However, Sachdeva does not expressly disclose a method in which the day and time that the dental presentation was patient is recorded. Clark teaches

system and method for informed patient consent wherein the time and date of when the presentation is given to the patient is recorded (i.e. updating records of the individual to correspond to acceptance of the at least one procedure in the presentation by the individual. (Figure 26; col. 25, line 61-col. 26, line 26, line 5) At the time of the Applicant's invention, it would have been obvious to one ordinary skill in the art to modify the method of Sachdeva with the teaching of Clark to record time and data when the presentation is given to the dental patient. As suggested by Clark, one would have been motivated to include this feature to enhance the quality of the patient-healthcare provider experience prior to medical procedures by presenting information to a recipient while confirming receipt and comprehension of the information by the patient (col. 3, lines 45-49)

Claim 61 has been amended to recite that the specific steps of incorporating data comprise scanning for markers identifying insertion point, retrieving the desired data, inserting data, and repeating these steps. Sachdeva does not expressly disclose that the steps of inserting/incorporating the data to create the desired presentation. However, it is noted that the use of markers in templates to indicate points of data insertion and the retrieval and insertion of the desired data for visual presentation is old and well known in the art. For example HTML tags may be used for this purpose in creating/customizing webpages. Also, Microsoft PowerPoint allows data to be imported from other applications (e.g. ClipArt) at selected points in a user's presentation template. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to include the steps of incorporating data by scanning for markers

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identifying insertion point, retrieving the desired data, inserting data, and repeating these steps (as needed). As suggested by Sachdeva, one would have been motivated to include this feature to facilitate the automation of treatment plan generation. (col. 3, lines 13-17)

[claim 62] See Sachdeva (col. 3, lines 55-col. 4, line 43)

[claim 63] Sachdeva teaches a method further comprising the step of editing the dental presentation to add additional dental procedures. (col. 7, lines 37-56)

[claim 66] Sachdeva teaches a method of claim 61, further comprising the steps of:

- generating a list of recommended dental procedures for the dental patient, wherein the recommended dental procedures are previously entered into the dental desktop application as being recommended for the dental patient; and (col. 4, lines 27-38)
- selecting at least one recommended dental procedure from the list of recommended dental procedures for inclusion in the recommended course of treatment. (col. 4, lines 27-65; col. 5, lines 11-48)

[claim 67] Sachdeva teaches a method further comprising the step of using the dental desktop application to select automatically all recommended dental procedures in the

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list of recommended dental procedures for inclusion in the recommended course of treatment. (col. 5, lines 11-48)

[claim 68] Sachdeva teaches a method further comprising the step of editing the list of recommended dental procedures to include the dental procedure for the dental patient. (col. 7, lines 20-36; col. 8, lines 33-57)

[claim 70] Sachdeva teaches a method further comprising the step of incorporating the dental procedure into the template includes for each dental procedure, the steps of:

- retrieving a procedure information file for the dental procedure, wherein the procedure information file includes a plurality of details related to the dental procedure including a member of the group comprising: test data, time for the procedure, medications for the procedure, post procedure follow up and combinations thereof; and (col. 4, lines 9-32; col. 6, lines 3-14)
- inserting the procedure information file into the dental template. (col. 4, lines 9-32; col. 6, lines 3-14)

[claim 71] Sachdeva teaches a method further comprising the step of editing the procedure information file prior to inserting the procedure information file into the dental template. (col. 7, lines 20-36; col. 8, lines 33-57)

[claim 73] Sachdeva teaches a method, wherein the step of storing the dental presentation in the dental desktop application includes the step of integrating the dental

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presentation into dental desktop application records for the dental patient. (col. 3, lines 36-col.4, line 23; col. 4, line 49-67— patient's treatment plan generated, stored and accessible to a plurality of parties)

[claim 74] Sachdeva teaches a method further comprising the steps of:

- indicating at least one dental procedure of the recommended course of treatment was accepted by the dental patient; and (col. 6, lines 3-43)
- updating records of the dental desktop application records for the dental patient to correspond to the indicated accepted dental procedure. (col. 6, lines 3-43)

7. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828), Clark, and Official Notice as applied to claim 61 and in further view of Parker (Microsoft Office 4 for Windows for Dummies)

[claim 64] Sachdeva and Clark teach the method of claim 63, as explained in the rejection of claim 63 above, but do not expressly disclose the use of plug-in tool bars for editing or exchanging information among applications for a dental presentation. Parker discloses the use of plug-in tool bars to edit presentations and to exchange information among applications (pp. 184, 195-200: eg. Clip art/ spell check/ word toolbars). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Sachdeva and Clark in combination, with the teaching of Parker to include the use of plug-in tool bars to edit presentations and to exchange data among applications. As suggested by Parker, one would have been

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motivated to include these features to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page. 195)

[claim 65] Sachdeva teaches a method wherein said step of editing the dental presentation comprises at least one of the steps of adding other information to the dental presentation, removing information from the dental presentation and changing information in the dental presentation. (col. 7, lines 20-36; col. 8, lines 33-57)

8. Claims 76-87 and 89-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828) in view of Parker (Microsoft Office 4 for Windows for Dummies) and in further view of Official Notice.

[claims 76 and 80] Sachdeva teaches a system for generating and displaying a dental presentation describing a recommended course of treatment having at least one dental procedure for a dental patient, the system comprising:

- a. at least one computer, wherein said at least one computer comprises at least one memory device, a dental desktop application stored in said at least one memory device, and a presentation tool stored in said at least one memory device; (col. 3, lines 36-col. 4, line 38)
- b. one step selection, merger and storage application for selecting a template for a dental presentation, (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15) and wherein said dental presentation is stored in said at least one memory device; (col. 3, lines 55- col. 4, lines 8)

- c. a presentation tool for presenting said dental presentation to said dental patient; and
(col. 4, lines 24-27: displaying treatment plan)
- d. a tracking tool, wherein when at least one dental procedure of said recommended course of treatment is accepted by a dental patient the patient records in the dental desktop application correspond to the accepted dental procedure. (col. 4, lines 24-27: displaying treatment plan; col. 6, lines 3-33—patient acknowledges simulated treatment results)

Sachdeva discloses the use of templates for creating the medical and dental presentations for patients as explained above, but does not expressly discuss the use of slides as part of the user presentation. Parker discloses that Microsoft PowerPoint allows users incorporate slides as part of a customized visual presentation. (Parker: pages 187-197) Microsoft PowerPoint also allows information to be automatically incorporated into the slide presentation. (Parker: pages 195-198) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Sachdeva with the teaching of Parker to include slides with information that has been automatically incorporated as part of a customized patient presentation. One would have been motivated to do this to improve or increase the visual impact of the presentation and to provide a quick and efficient way for a user to review and/or reformat the final presentation. (Parker: page. 195)

Claim 76 has been amended to recite that system contains specific components for incorporating data comprise scanning for markers identifying insertion point, retrieving the desired data, inserting data, and repeating these steps. Sachdeva does

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not expressly disclose that the steps of inserting/incorporating the data to create the desired presentation. However, it is noted that the use of markers in templates to indicate points of data insertion and the retrieval and insertion of the desired data for visual presentation is old and well known in the art. For example HTML tags may be used for this purpose in creating/customizing webpages. Also, Microsoft PowerPoint allows data to be imported from other applications (e.g. ClipArt) at selected points in a user's presentation template. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to include components for incorporating data by scanning for markers identifying insertion points, retrieving the desired data, inserting data, and repeating these steps (as needed). As suggested by Sachdeva, one would have been motivated to include this feature to facilitate the automation of treatment plan generation. (col. 3, lines 13-17)

[claim 77] Sachdeva teaches a system wherein the selection, merger, and storage application in a single action further incorporates general patient information into the dental presentation. (col. 3, lines 55-col. 4, line 43)

[claim 78] See Sachdeva: Figures 1-3; col. 3, lines 36-col. 4, line 65; col. 6, lines 43-46.

[claims 79 and 84-85] Sachdeva and Parker teach the system of claim 76, as explained in the rejection of claim 76 above. Sachdeva does not expressly disclose the use of plug-in tool bars for editing or exchanging information among applications for a dental

presentation. Parker discloses the use of plug-in tool bars to edit presentations and to exchange information among applications (pp. 184, 195-200: e.g. Clip art/ spell check/ word toolbars). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Sachdeva, with the teaching of Parker to include the use of plug-in tool bars to edit presentations and to exchange data among applications. As suggested by Parker, one would have been motivated to include these features to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page 195)

[claims 81-82] See Sachdeva: Figures 1-3; col. 4, lines 24-col. 6, line 15

[claims 83] Sachdeva and Parker teach the system of claim 76, as explained in the rejection of claim 76. Sachdeva discloses creating a dental presentation, but does not expressly disclose the use of slides and therefore, does not disclose a system further comprising an indicator configured to indicate a point of incorporation for at least one slide. Parker discloses a system for incorporating slides into a presentation (i.e. an indicator configured to indicate a point of incorporation for at least one slide) (pages 171-173). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Sachdeva with the teaching of Parker to include an indicator to indicate a point of incorporation for a slide having specific dental information on at least one dental procedure included in a recommended course of treatment. As suggested by Parker, one would have been motivated to include this

feature to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page 195)

[claims 86-87] See Sachdeva: col. 4, lines 9-38, 49-65; col. 5, lines 11-col. 6, line 15; col. 6, lines 43-46

[claim 89] Sachdeva teaches a system wherein the dental presentation stored in the at least one memory device comprises an integrator for integrating said dental presentation into dental desktop application records for said dental patient. (col. 3, lines 36-col.4, line 23; col. 4, line 49-67— patient's treatment plan generated, stored and accessible to a plurality of parties)

[claim 90] Sachdeva teaches a system wherein said dental presentation incorporates information from a dental database on a list of services offered by said dental practice (col. 4, lines 24, lines 27-35; col. 5, lines 11-31)

[claims 91-92] See (col. 4, lines 9-23; col. 5, lines 32-48)

Response to Arguments

9. Applicant's arguments with respect to claims 61-71,73-74,76-87, and 89-92 have been considered but are not persuasive.

(A) Applicant argues that the change in scope regarding the specification and the claims to specifically disclose and recite a dental application is not new matter.

In response, the Examiner respectfully disagrees. The Examiner acknowledges the citations provided by Applicant to attempt to address to new matter issues raised in

the previous Office Action. However, the Examiner does not find these citations to be sufficient. Page 6, line 4 of the originally filed specification suggests that the although the term "healthcare application desktop application" is used that application "may be in the context of a dental practice management software application." The Examiner was unable to locate page 17, line 18 in the specification as originally filed. Page 16, line 1 does not mention or discuss the details of a dental software application. More specifically, the Examiner is unable to find the level of detail for a method and system of using a software application to generate dental presentations that is currently required by the claimed invention (i.e. wherein specific dental information is incorporated, scanned as a marker or used to retrieve specific patient data) Therefore, the 112, 1st rejection is maintained.

(B) As per the Applicant's arguments regarding the new limitations, the Examiner has provided additional citations, explanations and new grounds of rejections to address the newly added features.

Conclusion

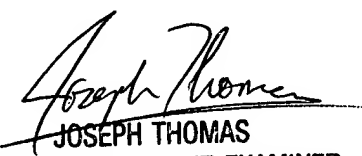
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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